Supreme Court, U.S.
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IN THE SUPREME COURT OF

THE UNITED STATES

LESLIE C. CASE, Plaintiff-Appellant-Petitioner,

v.

CPC INTERNATIONAL, Inc. and

COMMISSIONER OF PATENTS AND TRADEMARKS,

Co-Defendant-Appellee-Respondents.

PETITION FOR CERTIORARI

Leslie C. Case, pro se
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June 18, 1984

QUESTIONS PRESENTED FOR REVIEW

1. Will this Court hold the Patent and Trademark Office accountable to the standards of due process of law, and require that patent interferences be declared, conducted, and decided in accordance with statute, regulations, and applicable precedent?

2. Will this Court require the Court of Appeals for the Federal Circuit to conform its decisions to precedent established by this Court, and by its own prior decisions, and to recognize the principle of due process of law?

3. Will this Court act so as to protect the public interest in the integrity of the patent and judicial processes?

4. Is not a ruling against a patentee, in a patent interference declared, conducted, and decided contrary to constitutional standards of due process, conversion, giving rise to a claim under 28 USC 1346(b)?

5. Insofar as even accused (and convicted) felons have constitutional rights, why is it that patentees have none?

LIST OF PARTIES TO THE PROCEEDING SOUGHT TO BE REVIEWED

Plaintiff-Appellant-Petitioner, Leslie C. Case, a private inventor residing at 14 Lockeland Road, Winchester, Mass.

Co-Defendant-Appellee-Respondent, CPC International, Inc., a Corporation of Delaware.

Co-Defendant-Appellee-Respondent, The Commissioner of Patents and Trademarks.

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Decision in Patent Interference No. 98,302, Board of Interferences, dated October 29, 1976. Not officially reported.

Decision in CA 76-4516, District of Massachusetts, Case v. CPC et al, rendered and judgment entered on March 25, 1983. Not officially reported.

CASE v. CPC International, Inc. and Commissioner of Patents and Trademarks, Court Appeals, Federal Circuit, March 5, 1984, 730 F.2d 745. Rehearing in banc denied March 27, 1984.

STATEMENT OF GROUNDS FOR JURISDICTION

(i) The judgment in the Court of Appeals, Federal Circuit was dated (and apparently entered) on March 5, 1984.

(ii) A Suggestion for Rehearing in Banc was denied on March 27, 1984.

(iv) This Court has jurisdiction to review the judgment in question under 28 USC 1254(1).

LIST OF CONSTITUTIONAL PROVISIONS, STATUTES, and REGULATIONS INVOLVED

1. Amendment 5 to the United States Constitution.

2. 35 United States Code, 135(a) and(b).

3. 35 United States Code, 146.

4. Patent and Trademark Office Rules 204(a), 205(a) and (b), 206 (a) and (b). (37 CFR 1.204(a), 1.205(a),(b), 1.206(a), (b).)

5. Patent and Trademark Office Rule 341(g). (37 CFR 1.341(g)).

6. 28 United States Code, 1346(b).

(Texts given in the Appendix, starting on page A 72).

STATEMENT OF THE CASE

The Petitioner seeks a review by this Court of the decision in a Patent Interference No. 98,302 before the Board of Patent Interferences, review thereof by the District Court, District of Massachusetts, under 35 USC 146, and appeal thereof to the Court of Appeals, Federal Circuit. The position of the Petitioner is that the entire matter, from start to finish, has been grossly and wantonly mishandled by the Patent Office and the Courts. Respondents disagree, of course.

Petitioner is Leslie C. Case, a private inventor, residing at Winchester, Massachusetts, and patentee and owner of U.S. Patent No. 3,510,471.

Respondents are CPC International, Inc. (CPC), a corporation of Delaware, and owner of U.S. Patent Application Serial No. 105,684, and the Commissioner of Patents and Trademarks.

History of the Case

On January 3, 1967, CPC filed patent application Serial No. 606,596, entitled "Starch Polyethers and Processes for Producing Them," in the name of Hyman M. Molotsky as sole inventor. The initial claims, and all amended claims were directed to single components,not mixtures.

In the prosecution of Serial No. 606,596 all claims were rejected on the merits, the rejections were made final, and CPC took an appeal to the Board of Appeals. CPC filed a brief in that appeal in which it was stated (page 11): "Rather, appellant here is only attempting to antedate a narrow class of polyether products, namely those derived from a single reactant of a single specific known chemical structure, namely, starch."

A request for an oral hearing was made, and the hearing scheduled, but CPC then requested no action on the appeal, and

abandoned the application in favor of a continuation-in-part application.

Petitioner filed patent application Serial No. 621,768 on March 9, 1967. That application issued as U.S. Patent No. 3,510,471 on May 5, 1970, with claims directed to specific mixtures of oxyalkylated polysaccharides and oxyalkylated polyalcohols (polysaccharide polyethers and polyalcohol polyethers).

CPC filed patent application Serial No. 105,684 on January 11, 1971 (after U.S. 3,510,471 issued), and copied the claims of that patent into the application. Serial No. 105,684 was filed as a continuation-in-part of Serial No. 606,596, again in the name of Hyman M. Molotsky as sole inventor. Serial No. 606,596 was then abandoned in favor of the C-I-P Serial No. 105,684.

On November 10, 1972, the Examiner rejected the claims of U.S. 3,510,471 which had been copied into Serial No. 105,684,

stating (page 3):"applicant obviously does not have support for claims of the scope presented." On the same date, the Examiner rejected CPC's claims on the merits in view of 11 U.S. Patents, including Anderson, U.S. 2,902,478.

In the prosecution of Serial No. 105,684, CPC filed a total of four requests for extension of time in which to overcome the rejections on the merits. The said rejections were never addressed on the merits, and all claims stand, to date, as rejected on the merits.

On December 14, 1972, CPC filed an amendment cancelling all copied claims, and offering two sets of alternative claims, in an effort to obtain an interference with U.S. 3,510,471. Neither set of alternative claims was copied from U.S. 3,510,471, of course, in any meaningful sense. Both sets of claims read on mixtures, with no proportions of the components stated.

On April 6, 1973, the Examiner sent a notice to CPC, in which it was stated that an "interference would be declared on the basis of claims 61-71 which more clearly delineate the subject matter common to both applicant and patentee."

On April 26, 1973, Patent Interference No. 98,302 was declared on the basis of "phantom counts", which were claims of U.S. 3,510,471, with the weight proportions of the components of the mixture omitted.

Neither party took testimony in the interference. Applicant CPC never attempted to show support for the elements and limitations of either the claims of U.S. 3,510,471, or the counts.

The Board of Interferences awarded priority to CPC, on the basis of the earlier filing date of patent application Serial No. 606,596, and the allegation that Example 6 of Serial No. 606,596 answered to the claims of U.S. Patent No. 3,510,471,

relying on Den Beste v. Martin (CCPA,1958) 252 F.2d 302.

Petitioner then filed for a review under 35 USC 146 (this is a patent matter, and confers jurisdiction on the federal courts under 28 USC 1338(a)), in the District of Massachusetts. During the course of that review, it became apparent that counsel for CPC who filed the C-I-P application, and who prosecuted the interference, had been employed in Group 120 of the Patent Office during the time in which U.S. 3,510,471 was pending therein, and that said counsel left employment in that Group 120 less than 2 years prior to the filing of Serial No. 105,084 in that Group. It was also discovered during the course of that proceeding that CPC's invention of a mixture corresponding to the counts of the interference was a joint, not a sole, invention, and had never been the subject of a patent application.

On March 25, 1983, the district court affirmed the decision of the Board of Patent Interferences. The district court held that the conclusion of law of Squires v. Corbett (CCPA, 1977) 560 F.2d 424 simply does not mean what it says.

Appeal was then taken to the Court of Appeals, Federal Circuit. That court affirmed the decision of the lower court, without a hearing, and summarily denied Petitioner's suggestion for a rehearing in banc. The decision of the court of appeals held that explanatory language in Squires negated the conclusion of law therein, that there was no requirement on applicant for support (as in Holmes v. Kelly (CCPA, 1978) 586 F.2d 234), that the obvious fraud was in fact a misjoinder problem instead, and that decisions of the Board negated Weil v. Fritz (CCPA,1978) 572 F.2d 856 on that subject. The conflict-of-interest problem was ignored.

ARGUMENT AMPLIFYING REASONS RELIED UPON

I. The Award of Priority Against Patentee Petitioner is CLEARLY UNCONSTITUTIONAL

1. Amendment 5 to the Constitution requires that:

"No person shall . . . be deprived of . . . property, without due process of law . . ."

"the right as well as the mode, or manner, of acquiring property, and of alienating or transferring, inheriting, or transmitting it, is conferred by society; it is regulated by civil institution, and is always subject to the rules prescribed by positive law." Calder v. Bull 3 U.S. 386,394 (1798)

"the standpoint of due process (is) the protection of the individual against arbitrary action" Mr. Justice Cardozo in Ohio Bell Tel. Co. v. Pub. Util. Comm. 301 U.S. 292,302 (1936)

"There has not been the 'protection of the individual against arbitrary action' which Mr. Justice Cardozo characterized as the very essence of due process" Slochower v. Bd. Educat. 350 U.S. 551, 559 (1955)

"The fundamental guarantee of due process is absolute and not merely relative" Hammond Packing Co. v. Arkansas 212 U.S. 322, 350 (1908)

2. "That a patent is property, protected against appropriation both by individuals and by government, has long been settled"
Hartford-Empire Co. v. U.S.
323 U.S. 386, 415 (1944)

(The claims of the patent, of course, define the metes and bounds of the property owned thereby.)

3. The Patent Office Rules 204, 205, and 206 (37 CFR 1.204 through 1.206) were all violated in the declaration and decision of Patent Interference No. 98,302:

a) Rule 204(a) requires that an applicant seeking an interference with an issued patent must have made "the same invention" (See also Radio Corp. v. Radio Eng. Lab. 293 U.S. 1, 3)

When Respondent CPC cancelled the copied claims, after rejection thereof on the merits, it was established for all time that there were material differences between the copied claims and the claims of CPC, that Respondent CPC had disclaimed and

abandoned all matter embodied in those differences, and that the disclaimer must be strictly construed against Respondent. Exhibit Supply v. Ace Corp. 315 U.S. 126, 136-137 (1942).

Any argument that Respondent's new claims encompass the cancelled claims (by being broader, for example) or are equivalent thereto, cannot stand:

> "The (prospective) patentee, having acquiesced in their rejection, is no longer free to gain the supposed advantage of the rejected claims by a construction of the allowed claims as equivalent to them"
> Schriber-Schroth Co. v. Cleveland Trust 311 U.S. 211, 221-222(1940)

b) Rule 205(a) requires that an applicant present in his application claims copied from the patent with which interference is desired. Cancellation of the copied claims violated this rule. And the cancellation established materiality of all differences between the cancelled claims and the substitute claims of Respondent (Exhibit

Supply, supra, at 137).

c) Rule 206(b) sets forth the procedure to be followed: "When the examiner is of the opinion that none of the claims can be made, he shall reject the copied claims . . ." That rule was not followed. Instead, an ad hoc instruction was given.

4. 35 USC 135 states that "a final judgment adverse to a patentee . . . shall constitute cancellation of the claims involved from the patent".

Interference No. 98,302 has thus deprived Petitioner of property, namely the claims involved in the interference. The manifest failure to declare and conduct the interference in accordance with the rules, constitutes failure to employ due process and is manifestly UNCONSTITUTIONAL.

II. The Practices Employed in Interference 98,302 have been CONDEMNED by this Court, As Gravely Injurious to the Public.

1. Respondent CPC's claims, if and when issued as a patent, will considerably broaden, and make far less definite, the patent monopoly based on the contested invention. Much matter dedicated to the public by the issuance of Petitioner's patent will be withdrawn from the public domain.

The effect on the public of the issuance of a patent to an applicant prevailing in a priority contest with a patentee is exactly the same as the re-issuance of the patentee's patent. The original patent claims, defining the patented monopoly, are replaced by new claims, redefining the patented monopoly.

The issuance of a patent is a solemn public disclosure, claiming the invention sought, and disclaiming and dedicating to

the public, all else disclosed and not claimed therein. All such matter disclosed, and not claimed in the original patent claims, is public property. Mahn v. Harwood 112 U.S. 354, 360-1 (1884). The legal effect of dedication to the public cannot be revoked except by strict compliance with statute. Miller v. Brass Co. 104 U.S. 350, 352 (1882).

Claims expanded or made equivocal in a reissue (or thus after interference priority award) are a great injury to the public. Burr v. Duryee 68 U.S. 531, 577 (1864).

> "The reissued patent must be for the same invention, substantially, though it be described in terms more precise and accurate than the first patent. Under such circumstances, a new and different invention cannot be claimed." Battin et al v. Taggert 58 U.S. 74, 82 (1854)

See also Seymour v. Osborne 78 U.S. 516, 544 (1870)

> "Patents . . . may, in certain cases be surrendered and re-issued, but the new patent in such case must be for the same invention as the original patent; and if it is for a different invention, the re-issue is invalid, for the reason that it was granted without authority of law." Marsh v. Seymour 97 U.S. 348, 355-6 (1877)

2. Respondent CPC's application was never examined, and all claims therein stand as rejected. 35 USC 135(a) authorizes the Commissioner to issue a patent to an applicant who is adjudged the prior inventor, and it appears that the Patent and Trademark Office stands ready for such issuance in this instance, immediately after conclusion of the appeal process.

> "The Patent Bureau in this country is composed of men of scientific attainments, who examine the merits of every claimant of a patent. . . They are not expected . . . to grant a patent without inquiring, to every applicant who is ready to pay the fees. Such a course of conduct would be highly injurious to the public, by furnishing means to impose on the public by false pretenses, and with threats of expensive and ruinous litigation.
>
> The re-issue of valid patents with expanded or equivocal claims, where the

> original was clearly neither 'inoperative nor invalid', and whose specification is neither 'defective nor insufficient', is a great abuse of the privilege granted by the statute, and productive of great injury to the public." Burr v. Duryee 68 U.S. 531, 577 (1864)

> "Before the declaration of an interference all preliminary questions must be settled by the primary examiner, the issue clearly defined and the claims put in such condition that they will not require alteration"
> Ewing v. U.S. 294 U.S. 1,7-8(1934)
> Brenner v. Manson 383 U.S. 519,528 (1965)

a) The claims of Respondent CPC state no respective proportions for the components of the combination.

> "When the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be void."
> Wood v. Underhill 46 U.S. 1,4 (1847)

One is not entitled "to a patent monopoly, at least until a definite dilution point or range is discovered corresponding to a physical phenomenon" Dow Chemical v. Halliburton Oil Well 324 U.S. 320,329(1945).

"But neither the Circuit Court nor this court can overlook the question of patentability." Hill v. Wooster 132 U.S. 693,698 (1889)

"The principle of the Hill case is that the court must decide whether claims show patentable inventions before authorizing the Commissioner to issue a patent" Sanford v. Kepner 344 U.S. 13, 15 (1952)

b) The specification and examples of Respondent CPC do not state how much propylene oxide is to be added, or at what times. Nor can the amount be calculated.

"Both the times and manner in which the . . . solution is to be added may be ascertained as we have stated solely by experimentation. The disclosure . . . is therefore too vague and indefinite to constitute invention." Std. Brands v. National Grain Yeast Corp. 308 U.S. 34,38 (1939)

See also Incandescent Lamp Patent 159 U.S. 465, 474 (1895)

c) The combination of Respondent's claims (and of the phantom counts) is fully met by Anderson, U.S. 2,902,478. There is no novelty or patentability whatever, once the specific weight limitations of

Petitioner's patent claims are omitted.

d) Respondent CPC's claim for priority rests entirely on Example 6. Disclosure of one compound (even if operable) does not sustain a claim to a generic invention. Corona Cord Tire Co. v. Dovan Chem. Corp. 276 U.S. 358, 385 (1927).

3. Respondent CPC's assertion of priority is entirely fraudulent. The application Serial No. 606,596, the filing date of which is relied on for priority

does not correspond to Respondent's invention corresponding to that of Petitioner. In fact, Respondent never applied for a patent on the invention at issue.

> "There are issues of great moment to the public in a patent suit." Hazel-Atlas Co. v. Hartford-Empire Co. 322 U.S. 238, 245(1943)

> "The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud and other inequitable conduct and that such monopolies are kept within their legitimate scope." Precision Inst. v. Automotive Maintenance Machy. Co. 324 U.S. 806, 816 (1944)

> "Every element of the fraud here disclosed demands the exercise of the historic power of equity to set aside fraudulently begotten judgments." Hazel-Atlas Co. v. Hartford-Empire, supra, at 245

Furthermore, counsel for Respondent was in clear violation of the Patent Office Rule 341(g) (37 CFR 1.341(g)), regarding conflict of interest. This court seems not yet to have decided a case involving such facts, but there is a scholarly decision on

the matter by a different circuit court. In Kearney and Trecker Corp. v. Giddings and Lewis, Inc. (CA7, 1971) 452 F.2d 579, Judge (now Justice) Stevens held that violation of the conflict-of-interest rule equates to intolerable fraud on the Patent Office. The CAFC ignored both the fact of conflict of interest, and the decision of the other circuits on the topic. What could be more clear, than that tacit approval of such practice encourages and rewards conduct injurious to the public interest.

III. Failure to Comply with the Requirments of the Federal Code is Proper Basis for Tort Claims under 28 USC 1346(b).

> "The question is one of liability for negligence at what this Court has characterized as the 'operational leval' of governmental activity"
> Indian Towing Co. v. U.S., 350 U.S. 61, 64 (1955)
> Dalehite v. U.S. 346 U.S. 15, 42 (1952)

> "The Code is, of course, the law . . ., and the activities of federal agents are controlled by its provisions. They are required to follow the procedures there established."
> Hatahley v. U.S. 351 U.S. 173,178 (1955)

The U.S. is liable for claims under 28 U.S.C. 1346 where "government agents failed to comply with the terms of that Section." Hatahley, at 180.

> "The type of trespass subsumed under the Act's language making the Government liable for 'wrongful' acts of its employees is examplified by the conduct of the Government agents in Hatahley v. U.S."Laird v. Nelms 406 U.S. 797, 802 (1971)

In this case, of course, the Patent Office clearly violated 37 CFR 1.204-1.206.

IV. The CAFC (and Predecessor CCPA) Regularly Expand the Patent Act far Beyond Congressional Intent, and Create Law All Their Own.

> "It is our duty to construe the patent statutes as they now read, in light of our prior precedents, and we must proceed cautiously when we are asked to extend patent rights into areas wholly unforseen by Congress. As Mr. Justice White explained in writing for the Court in Deepsouth Packing Co. v. Laitram Corp. 406 U.S. 518, 531. . .:
>
> '(W)e should not expand patent rights by overuling or modifying our prior cases construing the patent statutes, unless the argument for expansion of privilege is based on more than mere inference from ambiguous statutory language. We would require a clear and certain signal from Congress before approving the position of a litigant, who, as respondent here, argues that the beachhead of privilege is wider, and the area of public use narrower, than courts had previously thought. No such signal legitimizes respondent's position in this litigation.'
>
> The judgment of the Court of Customs and Patent Appeals is reversed."
> Parker v. Flook 437 U.S. 584,596 (1978)

The CAFC, in deciding the instant case, has plainly held (Appendix, pages 57, 58 and

61) that it is not necessary to comply with the provisions of the Federal Code (37 CFR 1.204-1.206), and that "Phantom Count" interferences are beyond control of law and precedent. Numerous prior CCPA decisions were ignored and/or reversed in the ruling in the instant matter. (See Appellant's 15-page Suggestion for Rehearing in Banc for details).

In the past, this Court has had to act to bring the CCPA back under the rule of law and precedent (Parker v. Flook, supra).

Petitioner respectfully urges that that time has come once more, and that this Court must act, in the first instance, by granting this petition.

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Final Hearing
June 10, 1976

Paper No. 98
LHC/dm

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT INTERFERENCES

Patent Interference No. 98,302

Case v. Molotsky

Starch Polyethers, Starch-Based Polyethers, and Processes for Producing Them

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Patent granted Leslie Catron Case May 5, 1970, Patent No. 3,510,471, Serial No. 621,768 filed March 9, 1967

Application of Hyman M. Molotsky filed January 11, 1971, Serial No. 105,684. Accorded benefit of Serial No. 606,596 filed January 3, 1967

Mr. Leslie Catron Case for Case. Oral argument by Mr. Leslie Catron Case.

Floyd, Marion, Mitri, Price, Stemwedel and Leroy for Molotsky. Oral argument by Keith v. Rockey.

Gaston, Modance and Torchin, Examiners of Interferences.

Gaston, Examiner of Interferences.

Count 1

A polyether polyol consisting essentially of (1) an oxyalkylated aliphatic polyalcohol of the general formula:

$$P-\quad -O-(R-O)_n-H\ _f$$

and (2) an oxyalkylated polysaccharide of the general formula:

$$S-\quad -O-(R-O)_n-H\ _{f'}$$

wherein P is identical with the organic residue P attached to the alcoholic hydroxyl groups in a saturated aliphatic polyalcohol $P(OH)_f$ having from three to nine carbon atoms;

S is the organic residue attached to the active-hydrogen-containing groups of a poly-saccharide having at least three monosaccharide units per molecule, f and f', the functionalities, are positive integers with f having a minimum value of at least three and f' having a minimum value of at least 11, R represents a saturated aliphatic 1,2-alkylene radical of from two to six carbon atoms and the general formula:

$$-CH_2-\underset{R'}{CH}-$$

with R' being a saturated lower alkyl radical, and n is a positive number with an average value ranging from about 1.0 to about 3.0.

Count 2

A polyether polyol according to count 1 in which said organic residue S is derived from a polysaccharide which is soluble or partially soluble in water.

Count 3

A polyether polyol according to count 1 in which said residue P is derived from a saturated aliphatic polyalcohol having from 3 to six carbon atoms and from three to six hydroxyl groups and said organic residue S is derived from a polysaccharide selected from the group consisting of linear, branched, and cyclic dextrins.

Count 4

A polyether polyol according to count 1 in which R' is methyl.

Count 5

The polyether polyol according to count 3 in which R' is methyl.

Count 6

The polyether polyol according to Count 3 in which said polysaccharide residue S is derived from a British Gum.

Count 7

A polyether polyol according to count 1 in which said residue P is derived from a saturated aliphatic polyalcohol having from three to six carbon atoms and from three to six hydroxyl groups and said organic residue S is derived from a starch.

Count 8

A polyether polyol according to count 7 in which R' is methyl.

Count 9

A polyether polyol according to count 7 in which said polysaccharide residue S is derived from corn starch.

Count 10

A polyether polyol according to count 7 in which said polysaccharide residue S is derived from potato starch.

Count 11

A polyether polyol according to count 7 in which said polysaccharide residue S is derived from wheat starch.

The relation of the counts of the interference to the claims of the respective parties is as follows:

Count	Case	Molotsky
1	1(p)	61(p)
2	2(p)	62(p)
3	3(p)	63(p)
4	4(p)	64(p)
5	5(p)	65(p)
6	8(p)	66(p)
7	9(p)	67(p)
8	10(p)	68(p)
9	11(p)	69(p)
10	12(p)	70(p)
11	13(p)	71(p)

These are phantom counts in the interference being declared in accordance with 37 CFR 1.205 according to the procedure set forth in MPEP Sec. 1101.02

Par.C , pages 172.1, 173.

Count 1 is claim 1 of Case with the ranges of proportions of the oxyalkylated aliphatic polyalcohol and oxyalkylated polysaccharide omitted.

Count 2 is Claim 2 of Case with the proportions omitted and the expression "soluble or partially soluble in water" substituted for the expression "having a solubility in water at 25° C. of at least about 50 percent by weight."

Neither party took testimony. Both parties filed briefs, At final hearing Case appeared pro se. Molotsky was represented by counsel.

This proceeding is under 37 CRF 1.258.

The party Case states that it is an unconstitutional denial of equal protection of the law to deny a patentee involved in a phantom count interference the opportunity to amend his interfered-with patent so as to refer to a prior application (Case main

Brief, pages 7, 8 and 9).

It appears from the file history of this interference that in Paper No. 54, a paper received in the U.S. Patent Office on January 6, 1975, the party Case moved that his patent in the interference, U.S. Patent No. 3,510,471 be amended so as to refer to his previous U.S. Patent No. 3,382,217 and that he then be ruled entitled to the benefit of this U.S. Patent No. 3,382,217 for constructive reduction to practice of the alleged invention of the phantom counts of this interference.

In regard to this motion the Patent Interference Examiner referred the party Case to 37 CFR 1.171 and MPEP Chapter 1400 as to the procedures to be followed, that is, in this case, by reissue, where it is believed that the disclosure of a patent has inaccuracies. In the Commissioner's Decision of August 8, 1975 (Paper No. 76) it was set forth that, under the law, since

the Case patent in the interference makes no reference to his patent U.S. No. 3,382,217 Case cannot claim its benefit. 35 USC 120. See also Hovlid v. Asari, 305 F.2d 747, 134 USPQ 162 (9th Cir. 1962);Sticker v. Blaw-Knox Co., 405 F.2d 90, 160 USPQ 177 (7th Cir. 1968); Sampson v. Ampex Corp. 171 USPQ 686 (S.D.N.Y.), aff'd 174 USPQ 417 (2nd Cir. 1972).

The party Case has not sought to reissue his patent in this interference with an amendment referring to his U.S. Patent No. 3,382,217.

In his main brief the party Case states "It is thus clear that the phantom-count practice of the Patent Office comes into direct conflict with 35 USC 120, at least in this instance." It is not apparent what this conflict is. As pointed out above, as to 35 USC 120, the party Case has been advised as to amendment of a patent by way of reissue. See Sticker v. Blaw-Knox Co.,

167 USPQ 442 (N.D. Il., E. Div- 1970).

The party Case urges that there is no interference in fact because these limitations of the patent claims "from 10 to 95 percent by weight of" an oxyalkylated aliphatic polyalcohol and "from about 90 to 5 percent by weight of" an oxyalkylated polysaccharide which were omitted from the phantom counts "are clearly material and in fact critical" and that this is disclosed in the Case patent (column 6, lines 11-20). We do not agree. In her motion decision (Paper No. 38, page 2) the Primary Examiner held that (1) the file history shows that these allegedly material limitations in the patent claims were not considered necessary to establish patentability over the prior art; and (2) the difference between the broad ranges set forth in the patent claims and the absence of such ranges in the phantom counts as well as in Molotsky's corresponding claims do not represent a patentable

distinction so as to support a conclusion that no interference in fact exists. In short, it was the opinion of the Primary Examiner that the claims of Molotsky and the claims of Case do not represent patentably different inventions. The phantom counts, accordingly were deemed proper as the issue of the interference. For the above reasons we agree with this conclusion. The party Case urges in his brief that he patented a specific mixture consisting essentially of an alkoxylated aliphatic polyalcohol with a precisely defined range of alkoxy substitution and an alkoxylated polysaccharide while Molotsky has been endeavoring to patent alkoxylated starches and starch degredation products.

It is, of course, well known that starches are polysaccharides. The Case patent disclosure employs starches: column 4, lines 24; column 6, line 16; Example 10.

To prepare the compositions of his

claims corresponding to the counts Case shows alkoxylating polysaccharides having more than three monosaccharide units per molecule with a lower aliphatic epoxide with an aliphatic polyalcohol utilized as a coreactant (column 1, lines 14 to 17; column 3, lines 27 to 33). Example 2 shows reacting dried canary corn dextrin, glycerol and propylene oxide in the presence of the alkaline catalyst triethylamine.

Example 6 of Molotsky, in both his parent application S.N. 606,596 and in his application in the interference S.N. 105,684 shows adding glycerin, potassium hydroxide (the alkaline catalyst) and propylene oxide to starch (a polysaccharide) and reacting.

It is thus apparent that both Case and Molotsky disclose carrying out the same reaction so that both necessarily obtain the same product.

The party Case urges first that there is no interference in fact as to the omission

of the range of proportions from the phantom counts. The party Case urges that his range is specific and material.

The Primary Examiner held in her motion decision that (1) the file history of the Case patent showed that the limitations as to the percentages of the two components of the claimed composition were not necessary to establish patentability and (2) the differences between the broad ranges of the patent claims and the scope of the counts did not represent a patentable distinction.

The burden is on the party Case to show that proportions outside the patent claims and inside the counts are patentably distinct. This Case has not done. See Sakano v. Rutemiller, 158 USPQ 47 (Bd. Pat. Int. 1968); McCabe v. Cramblet, 20 CCPA 1220, 65 F.2d 459, 18 USPQ 71 (1933).

The party Case urges that Molotsky cannot support the phrase "consisting essentially of" because the Molotsky

applications "are replete with s tatements of utility for such damaging ingredients as large amounts of water, glycols, and also inert solvents, monosaccharides, disaccharides, and methyl glycoside."

In Example 6, in both Molotsky applications, monosaccharides, disaccharides and methyl glucoside are not present. Nor has it been shown by inter partes tests that the presence of water or glycols is detrimental to the making of the composition of the counts. Pages 9 and 10 of both Molotsky applications show that when water is present, glycols are formed by the process and these are separated from the desired product by dialysis.

The expression "consisting essentially of" renders the counts open to the inclusion of ingredients which would not materially affect the basic and novel characteristics of the compositions as defined in the balance of the claims. In re Janakirama-Rao, 50

CCPA 1312, 1316, 317 F.2d 951, 137 USPQ 893 (1963); In re Sutton, 41 CCPA 816, 211 F.2d 582, 101 USPQ 186 (1954).

The party Case also urges that Molotsky cannot support the lower limit of 3 monosaccharide units in the polysaccharide molecule. This matter appears in the phantom counts. However, the question of support in Molotsky for the phantom counts is irrelevant since neither party "supports" the phantom counts; this is the very reason the phantom count practice was employed ab initio in the instant interference. Hedgewick v. Akers, 497 F.2d 905, 182 USPQ 167, 169, Footnote 6 (CCPA 1974).

Since we have already determined above that an interference in fact exists herein and the phantom counts properly represent the common invention of the parties, then the disclosure in the application of the single species of invention, 80-fluidity starch, defined in the generic phantom count

constitutes constructive reduction to practice of the invention of the count. See Den Beste v. Martin, 45 CCPA 798, 252 F.2d 302, 116 USPQ 584 (1958); Fried v. Murray, 46 CCPA 914, 268 F.2d 223, 122 USPQ 361(1959).

The party Case states that Molotsky cannot "support" the term "saturated aliphatic polyalcohol having 3 to 9 carbon atoms -- and a minimum functionality of 3, "that Molotsky relies only on glycerol as support for this component." As pointed out above, under the Den Beste and Fried decisions, disclosure of only a single species, glycerol, which Case admits is disclosed in the Molotsky parent application, constitutes constructive reduction to practice of the generic invention of the count.

The party Case states that Molotsky "cannot support the degree of substitution specified for the sliphatic polyalcohol." Case does not explain what he means by this expression. No mention of "degree of

substitution" as such is found in the Case patent. In Molotsky Example 6, the proportion of polysaccharide in the mixture of polysaccharide and polyol comes within the Case range, column 7, line 16. The hydroxyl number shown by Molotsky Example 6 also comes within the Case range. The conditions of the reaction in Molotsky are substantially those shown by Case.

The party Case objects that, while phantom Count 6 is for British Gum, the corresponding claim 66 of the Molotsky application is for "soluble or partially soluble dextrin." We note that in the Molotsky "Statement under Rules 204(c) and 205(b)" filed in the Molotsky application in the interference there is included page 93 of the publication the Zimmerman and Lavine Handbook of Material Trade Names which shows that British Gum is dextrin, made by the incomplete hydrolysis of starch with dilute acids or by heating the dry starch.

The Molotsky application, page 5, line 7 clearly shows dextrin as a polysaccharide employed in the compositions of the Molotsky claims.

The party case urges that 37 CFR 1.205(a) requires that an applicant copy a patent claim and maintain that claim in his application in order to enter into an interference with the patent from which that claim is copied (Case main brief, pages 6,15).

It appears that Molotsky copied all the claims from the Case patent, the copied claims were rejected on insufficient disclosure (35 USC 112) and then Molotsky cancelled all copied claims, submitting other claims which were modifications of the patent claims.

This, says, the party Case (main brief page 15) "is clearly an ex parte estoppel" and that Molotsky, when he withdrew all copied claims, after rejection, "established once and for all time his inability to make

the claims of the patent." The inability to make the claims of the patent is irrelevant since the instant interference was declared on the basis of phantom counts, not patent claims.

The party Case urges that he has clearly established abandonment, suppression or concealment of the alleged invention corresponding to the phantom counts (apparently under 35 USC 102(g) by Molotsky; that in Molotsky application S.N. 606,596 filed January 3, 1967 Molotsky did not claim the mixtures as in the phantom counts of this proceeding; that it was only after discovering U.S. Patent No. 3,510,471 that Molotsky filed his continuing application Serial No. 105,684 on January 11, 1971 in which he copied claims from the Case patent U. S. Patent No. 3,510,471 thus presenting for the first time claims reading on mixtures.

Case states that this failure to

present claims to the alleged invention over such a very long time, more than four years, clearly establishes abandonment, concealment or suppression.

We do not agree. Example 6 which supports the Molotsky claims corresponding to the counts, is contained in both Molotsky applications. See Crown Cork and Seal Co., Inc. v. Ferdinand Gutman Co., 304 U.S. 821, 1938 CD 821 in which it was held that the disclosure being continuously before the Patent Office shows that the applicant intended to retain, not abandon the disclosed invention. See also Benedict v. Menninger, 20 CCPA 1138, 64 F.2d 1001, 17 USPQ 499 (1933) in which claims to the subject matter of the counts were first made in the applicant's third continuing application. The court held that Menninger had continuously pending in the Patent Office applications disclosing the subject matter of the counts with the right, so far as disclosure is

concerned, to make the claims at any time. Field v. Colman, 40 App. D.C. 598, 1913 CD 450 is there cited as to the rule that an application effects reduction to practice of everything that is disclosed therein, regardless of what is claimed. See also Walsko v. Smith, 26 CCPA 1141, 102 F.2d 815, 41 USPQ 215 (1939); Writer v. Kiwad, 20 CCPA 869, 63 F.2d 259, 16 USPQ 436 (1933).

The decision Brown v. Cambell, 41 App. D.C. 499, 1914 C.D. 170 cited by Case does not involve a situation such as in the present case which involves a continuing application. In Brown v. Cambell, the Court held "that Mr. Brown concealed this invention from the time it was made in 1904 until Mr. Campbell's machine was on the market in 1907, and that it was Mr. Campbell's disclosure of the invention to the public that inspired the Brown application." The Brown application, the first filed by Brown on that subject matter, was filed in 1907.

Cooper v. Roth et al, Interference No. 92,123, cited by Case is not a published decision and will not be discussed.

The party Case also urges that the Anderson patent, U.S. Patent No. 2,902,478, exactly meets the phantom counts of this proceeding.

This argument was presented in a motion to dissolve before the Primary Examiner and said motion was denied in a decision on motions rendered November 5, 1974, Paper No. 38.

Patentability over prior art is not an issue ancillary to priority. See Glass v. de Roo, 44 CCPA 723, 239 F.2d 402, 112 USPQ 62 (1956); Ferree v. Shepard, 55 CCPA 848, 384 F.2d 1019, 155 USPQ 464 (1967). The jurisdiction of the Board of Patent Interferences is limited to a determination of the question of priority of invention, 35 USC 135. Accordingly, the asserted Anderson reference will not be discussed further.

The party Case urges that there is no disclosure in the Molotsky example of the amount of alkylene oxide either employed or combined or any product weights disclosed which would enable the calculation of the amount of combined alkylene oxide by difference.

As to the proportion of propylene oxide used by Molotsky, Molotsky in Example 6 employs sufficient propylene oxide and additional increments are added over a 2-1/4 hour period. Page 6 of the Molotsky application states that the amount of etherifying agent used depends primarily upon the moles of alkylene oxide desired per anhydroglucose unit in the final product; that he has used sufficient alkylene oxide to produce polyethers having a M.S. (moles of alkylene oxide per anhydroglucose unit) of from about 3.5 to about 50 or more and that usually the approach of the end point of a reaction is indicated by a decrease in the pressure

within the reaction vessel. Thus, in Example 6, the M.S. number was 6.6.

As to the amount of propylene oxide to be used in the Molotsky examples, as stated by Molotsky the examples show this in indicating the hydroxyl number of the product.

As to the mode of addition of alkylene oxide not being fully specified as urged by the party Case - we consider that a matter within the skill of the art. Molotsky points out (brief, page 28) that the prior art cited in the Case file wrapper shows this.

The party Case further urges that stirring is necessary for the alkylene oxide reaction and that Molotsky application Serial No. 606,596 discloses no such agitation. We agree with Molotsky that stirring is within the expected skill of a worker in the art.

With respect to the issue of no interference in fact, the party Case states that the phantom counts specifically call

for a mixture consisting essentially of two components. As has been pointed out above, "consisting essentially of" renders the counts open to the inclusion of ingredients which would not materially affect the basis and novel characteristics of the compositions as defined in the balance of the claim. In re Janakirama-Rao, supra; In re Sutton, supra.

The party Case urges that its patent, column 4, lines 51-56 discloses that the polysaccharides should not contain more than one per cent of water. However, the preceding line says that this is to obtain optimum results. Thus water is not excluded. This one per cent of water in the Case patent appears to be related to the production of polyurethane foams, column 4, lines 51 to 53. However, the product of Molotsky has other utilities, such as film forming, page 22 of Molotsky, and as a surfactant, as shown by page 25 of Molotsky.

As stated by the party Case, the water

content in the reactants is converted to diol during the reaction. Case states that diol content beyond a minimal level has a deleterious effect on the properties of the claimed composition in the manufacture. No basis is found for this statement in the Case patent.

However, Molotsky in his application, page 7, recognizes that the alkylene oxide reacts with water to form glycols, page 7, lines 5 to 9; pages 9 and 10. As shown by page 7, the glycols can be removed by dialysis. Molotsky example 6 speaks of the non-dialyzable portion of the reaction product. As set forth above, this portion would be free of the glycols by the dialysis. Accordingly, this product is that disclosed and claimed by Case and therefore an interference in fact does exist.

The party Case urges that he "has established priority over the alleged invention of the applicant" by his service

under 37 CFR 287(a) of documents and lists on the party Molotsky (Paper No. 60). In the above paper Case states "Patentee does not intend to call any witnesses concerning his own conception and reduction to practice." The party Case cannot rely on his documents and lists alone for this purpose. Testimony, and exhibits not taken in accordance with CFR 1.251 et seq. and CFR 1.271 et seq. cannot be considered by this Board. CFR 1.271 states:

> Evidence touching the matter at issue which shall not have been taken and filed in compliance with this part will not be considered in determining the interference or other proceedings.

Since the documents are not properly part of the record, they will not be discussed further.

In his "Brief in Rebuttal," page 8 (Paper No. 92), the party Case states that this board has the duty to consider certain motions to dissolve this interference which the Interference Examiner failed to transmit.

The motions in question are not identified. This matter was not petitioned. The propriety of the transmission of motions to the Primary Examiner is not within our jurisdiction. The jurisdiction of this Board under 35 USC 135, as set forth above, is the determination of priority of invention and does not extend to the above motions.

For all these reasons the party Molotsky must prevail in this interference.

Priority of invention of the counts in issue is awarded to Hyman M. Molotsky, the senior party.

L.H.Gaston
Examiner of
Interferences

Walter A. Modance
Examiner of
Interferences

Norman G. Torchin
Examiner of
Interferences

Board of Patent Interferences

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

LESLIE C. CASE, Plaintiff	)	CIVIL ACTION
v.	)	No. 76-4516-MC
CPC INTERNATIONAL, INC., Defendant	)	

JUDGMENT

March 25, 1983

Mc NAUGHT, D. J.

In accordance with the Findings of Fact and Conclusions of law issued by the court this date, it is hereby ORDERDD, ADJUDGED and DECREED that judgment be and hereby is entered for the defendant, with costs.

(John J. McNaught)
UNITED STATES DISTRICT
JUDGE

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

LESLIE C. CASE, Plaintiff	)	
	)	CIVIL ACTION
v.	)	
	)	No. 76-4516-MC
CPC INTERNATIONAL, Inc., Defendant	)	

FINDINGS OF FACT AND
CONCLUSIONS OF LAW

March 25, 1983

McNAUGHT, D. J.

Dissatisfied with the decision of the Board of Patent Interferences of the Patent and Trademark Office, the plaintiff, Leslie C. Case, commenced this action under Title 35 U.S.C. Par. 146 for review. Priority of invention was awarded to defendant CPC in Interference No. 98,302.

The plaintiff resides in Winchester, Massachusetts, and is the inventor and owner of U.S. Patent No. 3,510,471, issued May 5, 1970, on an application filed March 9, 1967. The defendant CPC International, Inc. ("CPC"), a Delaware corporation, is the owner of U. S.

patent application Serial No. 606,596, filed in the name of one Hyman Molotsky January 3, 1967, refiled January 11, 1971 as continuation-in-part application Serial No. 105,684. The Patent Office declared an interference between the Case patent and CPC application No. 105,684 on April 26, 1973. The decision of the Board of Patent Interferences awarding priority in favor of CPC was rendered October 29, 1976, following which plaintiff brought this suit for review. There is no contention other than that this court had jurisdiction and that venue is proper; additionally, the action was brought within the statutory period. Post-trial argument took place February 28, 1983.

On January 3, 1967, the first Molotsky application was filed. It was entitled "Starch Polyethers and Processes for Preparing them". The following description is to be found in defendant's Exhibit No. 4

at p. 3 *et seq.*:

> "Starch is reacted, preferably, with an alkylene oxide in an autoclave in the presence of an alkaline catalyst . . . the reaction is carried out for a sufficient period of time so that the reaction products obtained are polyethers having an average M.S. of about 3.5 to about 50 or more (the term M.S. is used to denote the moles of alkylene oxide per anhydroglucose unit)."

The application also taught that a reactive, rather than inert, solvent could be used. The first example was glycerin. That application, in Example 6, described a polyether polyol prepared by reacting glycerin and propylene oxide. The amount of propylene oxide used to carry out the reaction was not described.

In January of 1971, the continuation-in-part application was filed, containing all of the disclosure of the original, including Example 6, and new disclosure.

Dr. Case's patent was issued on an application filed on March 9, 1967, and was directed to polyether polyols. The polyether

polyol claimed in the patent was a mixture produced by reacting a polyalcohol such as glycerin and a polysaccharide (such as starch) with an alkylene oxide. That patent taught that the polyalcohols to be oxyalkylated were those aliphatic alcohols containing 3 to 9 carbon atoms and a minimum of 3 OH groups. The patent specified that the mixture called for by the claims contained 10 to 95% of the oxyalkylated polyalcohol by weight and 90 to 5% by weight of the oxyalkylated polysaccharide. Starch is one of the polysaccharides. In the 1971 Molotsky application, the Case patent was mentioned. Molotsky presented his Claims 61 to 71 as defining the same subject matter as the Case patent claims; hence, in April of 1973 the Patent Office declared Interference No. 98,302. Molotsky was given the benefit of the 1967 filing date, by reason of which he was accorded senior status. Case then bore the burden of proof of priority of invention.

Dr. Case (as here) there contended that there was no interference in fact because the counts which were constituted by the Patent Office omitted a material statement as to proportions. Since, Dr. Case contended, the Molotsky application failed to exclude more than 1% water and included mono or di-saccharides, they were not seeking to patent the same invention. It followed, he claimed, since they were not patenting the same invention, that Molotsky could not make the phantom counts. In November of 1974, the Examiner denied Dr. Case's motion to dissolve, ruling specifically that the claims of Molotsky and the claims of Case did not represent patentably different inventions, and that accordingly the phantom counts were proper for purpose of interference.

Ultimately the decision was issued in favor of Molotsky (defendant's Exhibit 1). The Board agreed with the conclusion of the Primary Examiner and noted that Example 6,

appearing in both Molotsky applications, was the same reaction as described in the Case patent. The conclusion: "It is thus apparent that both Case and Molotsky disclose carrying out the same reaction so that both necessarily obtain the same product." The Board also ruled that Dr. Case had failed to prove the proportions outside the patent claims but inside the counts were patentable. At p. 416 of defendant's Exhibit 1 (p. 15 of paper 98), the third paragraph reads:

> "The party Case further urges that stirring is necessary for the alkylene oxide reaction and that Molotsky application Serial No. 606,596 discloses no such agitation. We agree with Molotsky that stirring is within the expected skill of a worker in the art."

And, finally, at p. 17, "Priority of invention of the counts in issue is awarded to Hyman M. Molotsky, the senior party."

At argument, plaintiff conceded, in response to questions by the court, that he has the burden, on this review of the interference proceeding, of demonstrating

that the Patent Office decision should be overturned. Defendant's exhibit 1 consists of 424 pages; a certified copy of the Patent and Trademark Office file history of Interference No. 98,302. Having read these, one must conclude that the arguments presently offered to this court are, almost entirely, matters that were presented to the Board. The plaintiff, Dr. Case, insists now, as he insisted then, that there could not be a properly constituted interference proceeding because CPC could not copy verbatim the Case patent claims. He argued then, and argues now, that the phantom counts were improperly constituted; that CPC was required to demonstrate full support for Case's patent claims. He protested then, and protests now, that "Patent Interference No. 98,302 was thoroughly informal and irregular. As shown at trial, and in the post-trial brief, the Patent Office did not even attempt to follow its own rules and

applicable legal precedents in its declaration and handling of Interference No. 98,302."

First, as to the alleged irregularity of the proceeding before the Patent Office: referring to CPC's conduct as "severely tainted practice" . . . "based on the proposition that anything goes", the plaintiff avers "clear conflict of interest engaged in by counsel" (Halluin), who supposedly was "recruited out of Group 120 by a deliberately circuitous route . . .to prosecute not only Interference No. 98,302, but other interferences as well." This court finds no violation of the Patent Office conflict of interest rule. On May 26, 1981 Dr. Case was notified (Exhibit CN) of the fact that Mr. Halluin had been allowed to engage in the preparation and prosecution of certain patent applications. I do not find any bar to his working with the Molotsky application. No error has been

demonstrated on the part of the Patent Office in this regard.

Along the same lines, the plaintiff has complained of "false signatures", apparently instances in which secretaries of lawyers with the defendant CPC signed the names of their superiors to papers. There is no merit to that claim in this proceeding.

In summary, the plaintiff's claim of "violations of practice and precedent" engaged in by the defendant and by the Patent Office are so weak, lacking evidentiary support, that they provide no foundation for a reversal of the action of the office.

Plaintiff next asserts that the presumption of correctness of the Patent Office decision has been overcome by reason of failure of the Patent Office to require CPC to "copy into (its) application the identical claim of the issued patent, word-for-word." Quoting directly from plaintiff's reply brief to CPC's post-trial brief:

"Defendant's application did not describe or support anything like the identical invention of Plaintiff's patent. Defendant did not attempt to support the invention of Plaintiff's patent, or the so-called 'phantom' count, either before the Board of Interferences, or at trial." He quotes Squires v. Corbett, 560 F.2d 424 (Cust. and Pat. App. 1977), at p. 435: "We conclude that for an applicant to have a right to copy a patent claim he must have support for the full scope of the claim." I am in agreement with the defendant and its contention that the plaintiff misinterprets Squires v. Corbett, in that he refuses to make the distinction between the phantom count, a patent claim, and an application claim. This distinction is made by the court in Squires, at p. 432, and the court writes, beginning at the bottom of that page:

> "As a prerequisite to the declaration of an interference under 35 U.S.C. Par. 135(a) and 37 CFR 1.201(a), the Comm-

> issioner must decide that the 'application claim', whether or not identical to the 'patent claim', is both patentable and drawn to substantially the same invention as the 'patent claim'. Failure of either condition precludes the possibility of interference contemplated by the statute. The 'count',on the other hand, is merely the vehicle for contesting priority which, in the opinion of the Commissioner, effectively circumscribes the interfering subject matter, thereby determining what evidence will be regarded as relevant to the issue of priority. The 'count', as distinguished from a party's 'claim', need not be patentable to either party in the sense of being fully supported by either party's disclosure. In fact, where the interference is conducted on a 'phantom' count, as described in Par. 1101.02 of the Manual of Patent Examining Procedure (Third Ed.), or on the basis of a modified patent claim in accordance with 37 CFR 1.205(a), at least one party, by definition, will not have full support for all of the limitations of the count."

If, then, Claim 61 of the Molotsky application was drawn to substantially the same invention as the patent claim (as was determined by the Commissioner of Patents), that is sufficient. It seems to me that the plaintiff had the burden of showing that the patent and the application were directed to

different inventions, and that the plaintiff did not carry this burden. The patent and the Molotsky application described the same invention.

At trial, Dr. Stanley Parmerter, at one time a section leader of CPC, author of a review of starch chemistry, appearing in the Kirkothermer Encyclopedia of Technology, testified on reactions between alkylene oxides and polyols and how those reactions related to the Case patent and the Molotsky application. He compared Claim 61 of the second Molotsky application (defendant's Exhibit 5) with Claim 1 of the Case patent (defendant's Exhibit 2) and expressed the opinion, after review, that they were directed to the same general subject matter; that he compared the polyhydroxy compounds as specified in Claim 61 with the limitations of Claim 1 of the Case patent, and that polyhydroxy compounds listed in Claim 61 (glycerin, methylglucoside and propyleneglycol glu-

coside) met the limitation in Case Claim 1 with respect to the polyol. He testified that the oxyalkylated polysaccharide as set forth in Claim 61 of the Molotsky application was the same material as the oxyalkylated polysaccharide referred to in Case patent Claim 1. Case's patent claim and Molotsky's application Claim 61 were both directed to the invention of reacting an alkylene oxide with starch and glycerin. I accept the testimony of this expert witness and adopt it as a part of my findings. I emphasize the testimony as affirmative support for the holding of the Board, and as emphasis for the conclusion that the plaintiff failed to carry his burden of proving the opposite.

Plaintiff urged alleged differences between his Claim 1 and application Claim 61, such as a weight limitation in the patent claim and the number of carbon atoms in the organic residue of the polyol. These were not material differences. In his post-trial

brief, in a listing entitled Table I, the Plaintiff claims 12 material differences to exist. The Patent Office dealt with these and concluded, as recited hereinbefore, that they disclose carrying out the same reaction so that both necessarily obtain the same product. In other words, these are not material differences; they show employment of language of different scope and illustrate simply that CPC's claims are broader but that both claims define common subject matter.

Subsequent to the trial of this matter, the plaintiff argued, by way of brief, that CPC "is estopped from making the claims of plaintiff's issued patent, because defendant CPC International cancelled (emphasis in original) all the copied claims . . .after rejection thereof by the Examiner, because of lack of support therefor.. . ." Quoting further at p. 25 of the plaintiff's post-trial brief, ". . .Indeed, the seeking out

of an interference after cancellation of copied claims seems to be totally unprecedented." Research reveals that the cases cited as authority are inapplicable to the present situation. Here, the defendant in this suit for review presented claims which the Patent Office held were directed to the same invention. Priority was contested in this instance.

Plaintiff next falls back upon an argument which was ruled out in the course of trial: that the counts of the interference are unpatentable. This is a case in which the plaintiff lost in the Patent Interference and has brought a civil action for review. If the claim of priority is groundless, the district court does not adjudicate patentability, Sanford v. Kepner, 344 U.S. 13(1952)

The Molotsky application, Example 6, teaches the preparation of the product, despite the plaintiff's claim that the word "stirring" should have been used. Parenthet-

ically, the need to vent the pressure vessel should be equally apparent to a skilled chemist as a matter of common safety. The Molotsky application described properly a polyether polyol in January of 1967, an earlier date for the subject matter than the Case filing date. I adopt, therefore, the conclusions of law proposed by the Defendant, including the following:

The Case patent in suit is directed to a mixture of an oxyalkylated polyalcohol and an oxyalkylated polysaccharide, and includes a mixture of oxyalkylated glycerin and an oxyalkylated starch.

The Molotsky applications here involved both properly disclose within the meaning of 35 U.S.C. 112 a mixture of an oxyalkylated glycerin and an oxyalkylated starch as called for by the Case patent claims, and thus the Case patent claims embrace Example 6 appearing in both Molotsky applications.

Case, having proved no earlier date than his March 1967 filing date, is restricted to that date for purposes of priority of invention.

Molotsky is entitled, for purposes of priority, to his filing date of January, 1967.

Since the Molotsky filing date is earlier, Molotsky is the first inventor of the subject matter of the Case patent claims.

CPS is thus entitled to a judgment dismissing the complaint, together with costs as provided by law.

(John J. MCNaught)
UNITED STATES DISTRICT JUDGE

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

LESLIE C. CASE,	)	
	)	
Appellant,	)	
	)	
v.	)	Appeal No.
	)	
CPC INTERNATIONAL, INC.,	)	83-964
and	)	
COMMISSIONER OF PATENTS AND TRADEMARKS	)	
	)	
Co-Appellees.	)	

DECIDED: March 5, 1984

Before KASHIWA and NIES, Circuit Judges, and KELLAM,*/ Senior District Judge.

NIES, Circuit Judge.

This appeal is from the judgement of the United States District Court, District of Massachusetts, entered March 25, 1983, upholding the award of priority to CPC International, Inc., (CPC) in an interference proceeding in the United States Patent and

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*/ The Honorable Richard B. Kellam, Senior District Judge, United States District Court for the Eastern District of Virginia, sitting by designation.

Trademark Office (PTO).

The action was brought in the district court under 35 U.S.C. Par. 146. Our jurisdiction is based on 28 U.S.C. 1295(a)(1).

Appellant, Dr. Leslie C. Case, is the owner of U.S. Patent No. 3.510,471 and is the inventor named therein. Dr. Case asserts that an interference between his patent and application Serial No. 105,684 was improperly declared by the PTO and that the district court erroneously upheld the award of priority to CPC in that proceeding.

Dr. Case puts forth numerous substantive and procedural errors as grounds for reversal of the district court's decision. Having considered each of Case's arguments, we affirm. We also affirm the district court's dismissal of the Commissioner of Patents and Trademarks as a co-defendant.

Background

The inventions of the parties are directed to polyether polyols.

CPC is the owner of two patent applications relevant here, in both of which Hyman M. Molotsky is the named inventor. On January 3, 1967, the first Molotsky application, Serial No. 606,596, was filed claiming certain starch polyethers and processes for preparing them. The following description is to be found therein:

> Starch is reacted, preferably . . .with an alkylene oxide in an autoclave in the presence of an alkaline catalyst .. . . The reaction is carried out for a sufficient period of time so that the reaction products obtained are polyethers having an average M.S. of about 3.5 to about 50 or more (the term M.S. is used to denote the moles of alkylene oxide per anhydroglucose unit).

The application also taught that a reactive solvent, for example glycerin, could be used rather than an inert solvent. Example 6 described a polyether polyol prepared by reacting glycerin starch and propylene oxide.

In January of 1971, CPC filed a continuation-in-part application, Serial No. 105,684, containing all of the disclosure

of the original, including Example 6, and new disclosure. This application became the application of the subject interference.

Dr. Case's patent was issued on an application filed on March 9, 1967, and is directed to polyether polyols. The polyether polyol claimed in the patent is a mixture produced by reacting a polyalcohol, such as glycerin, and a polysaccharide, such as starch, with an alkylene oxide. The Case patent teaches that the polyalcohols to be oxyalkylated are those aliphatic alcohols containing 3 to 9 carbon atoms and a minimum of 3 OH groups. The claims specify 10 to 95% of oxyalkylated polyalcohol by weight and 90 to 5% by weight of oxyalkylated polysaccharide. Starch is one of the polysaccharides. It is undisputed that the product of Example 6 in CPC's application falls within claim 1 of the Case patent.

In order to provoke an interference with Dr. Case's '471 patent, CPC copied the

patent claims into the '684 application. This tactic proved unsuccessful. The examiner of the '684 application rejected the allowance of these claims to CPC under 35 U.S.C. Par. 112, first paragraph, inasmuch as CPC's disclosure did not support these claims, in particular the weight limitations. The examiner went on to state:

> However, since common subject matter is involved in the above patent and the instant application, applicant is advised to submit claims directed to a polyether polyol which is the reaction product of starch and the various disclosed derivatives thereof with glycerin and propylene oxide. See M.P.E.P. 1101.02(f); In re Ziegler, 150 U.S.P.Q. 551; Rule 205(a).
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> * * *
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> Upon making the said claims, the interference will be instutited on the basis of the corresponding claims of the Case patent as the counts to which applicant's claims will correspond substantially.

After CPC cancelled the rejected claims and submitted other claims in accordance with the above, the subject interference was declared on the basis of

"phantom" counts devised by the office to circumscribe what the examiner perceived to be the interfering subject matter. The interference counts here are demoninated "phantom" counts because none are the same as claims in either Case's patent or CPC's application. The counts are broader than claims made by either party. Significantly, both the counts and CPC claims omit the weight limitations found in the Case patent claims. This controversy, to a great extent, centers around this omission.

After consideration of many of the arguments raised here, the board awarded priority to CPC and this decision was upheld in the district court. Our reasons for affirmance of the award are set forth below.

I

The award of priority to CPC was determined by the fact that the effective filing date of the CPC application containing the interfering subject matter, January 3, 1967, preceded by three months the filing

date of Dr. Case's application leading to the issuance of the '471 patent. Dr. Case offered no evidence to establish an earlier date. Thus, the dispute in this interference is not directed to dates of invention but to collateral matters.

The essence of Case's case is that no interference was properly declared. In particular his arguments center on the propriety of the phantom counts of the interference.

II

As an initial matter, Dr. Case argues that the interference was improper because the board refused to review the patentability of the counts of the interference over the prior art. The board held that its jurisdiction did not extend to this issue, and we are entirely in agreement. In an interference, the issue is priority of invention. 35 U.S.C. Par. 135.[1/] Only that

1/ 35 U.S.C. Par. 135 reads, in pertinent (Cont'd)

issue and issues ancillary thereto are within the jurisdiction of the Board of Patent Interferences. Tofe v. Winchell, 645 F.2d 58, 209 USPQ 379 (CCPA,1981). It is correct that an application may not be placed in interference until it has been examined and the claims therein have been adjudged by the examiner to be allowable but for the issue of priority. However, after the matter reaches the board, the board does not reexamine the issue of patentability over the prior art and, indeed, is juris-

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1/ Cont'd:

part :

(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor.

dictionally precluded from such reexamination.

While the Court of Customs and Patent Appeals has held a number of issues to be ancillary to the issue of priority, patentability of a party's claims over prior art or patentability of the interference counts over prior art has been consistently and firmly rejected as an issue within the Board's jurisdiction. Glass v. De Roo, 239 F.2d 202, 112 USPQ 62 (CCPA 1956) and cases cited therein; Kahn v. Phipard, 397 F.2d 995, 158 USPQ 269 (CCPA 1968); Tofe v. Winchell, 645 F.2d at 64, 209 USPQ at 385 (Markey, C. J., concurring). Moreover, the counts of the interference serve merely as a "vehicle for contesting priority." Squires v. Corbett, 560 F.2d 424, 433, 194 USPQ 513, 519 (CCPA 1977). No purpose would be served in determining patentability of the count itself over the prior art, particularly a phantom count, which by definition neither party asserts as a claim.

Despite this authority, appellant asserts that "patentability" is always a threshold issue in an interference. In support of this position appellant makes an elliptic quotation from Hilborn v. Dann, 546 F.2d 401, 403, 192 USPQ 132, 132 (CCPA 1976), for the proposition "(T)he 'threshold' question . . . . is patentability of the count." The quotation merely illustrates the delusion in citing as precedent a sentence from a judicial opinion without regard to the issue before the court. Whether the board must determine patentability over prior art in the interference proceeding was not an issue in Hilborn. The party Hilborn sought a writ of mandamus to compel resumption of a suspended interference and to preclude review by the Commissioner of a decision by the primary examiner that Hilborn's application (which contained the count as a claim) was not entitled to be in the interference. The issue concerned the

court's authority to control the Commissioner's exercise of discretion in setting up or dissolving an interference, not the jurisdiction of the board. In any event, the precedent which is controlling has been indicated above.

Dr. Case also asserts that the phantom counts are "so broad as to fail to particularly point out and claim the invention in issue, and the 'phantom' counts are thus unpatentable under 35 USC 112."

Case confuses "claims" and "counts" throughout his argument but never is wider of the mark than here. The purpose of the count is to determine what evidence is relevant to the issue of priority. Squires v. Corbett, 560 F.2d at 433, 194 USPQ at 518-19. 35 U.S.C. Par. 112, second paragraph, relates only to actual claims.2/ While an

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2/ The subject provision reads:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject

(Cont'd)

attack can be made against the count of an interference because of its breadth, as discussed infra, the foundation for this challenge does not lie in 35 U.S.C. Par. 112.

One final "patentability" issue is raised by appellant's argument that CPC failed to name a co-inventor in the Molotsky application. The Court of Customs and Patent Appeals repeatedly held that third party inventorship is not an issue ancillary to priority. Mortsell v. Laurila, 301 F.2d 947, 950, 133 USPQ 380, 384 (CCPA 1962). Schwarzenbek v. Evering, 357 F.2d 1018, 1021, 149 USPQ 213, 216 (CCPA 1966). We agree with the holdings of the Board of Patent Interferences that the issue of propriety of joinder is basically the same as the issue of third party inventorship and is not ancillary to priority for similar reasons. See Ziemba v. Richter, 186 USPQ

2/ Cont'd.
matter which the applicant regards as his invention.

551, 553 (Bd. Pat. Int. 1975), Willis v. Suppa, 209 USPQ 406, 410 (Bd. Pat. Int. 1980)

The decisions of the Court of Customs Patent Appeals cited on the foregoing issues involved review of the Board of Patent Interferences on a direct appeal under 35 U.S.C. Par. 141. That the challenge to the Board's decision was first made in a district court under 35 U.S.C. Par. 146 has no effect on the jurisdiction of the board of the applicability of the above principles in this case.

We also reaffirm the validity of the practice, specifically endorsed in Aelony v. Arni, 547 F.2d 566, 570, 192 USPQ 486, 490 (CCPA 1977), that in appropriate circumstances, phantom counts may be used to define the subject matter of an interference, whether it involves two applications or a patent and an application, and we reject appellant's broadside attack on this procedure. Specifically, we reject Case's contention

that an interference could only be declared if CPC copied his patent claims precisely. The import of 35 U.S.C. Par. 135(b) is clearly to the contrary.3/ See also 37 C.F.R. Par. 1.205.

III

Dr. Case challenges the declaration of the interference on the ground that no interference in fact exists. Relying on Nitz v. Ehrenreich, 537 F.2d 539, 190 USPQ 413 (CCPA 1976), Case argues that the question of interference in fact turns on whether or not the weight limitations present in the claims of Case's patent but omitted from the counts are material. We agree with this analysis but we see no departure by the board or the court in stating the law or applying it to the facts of this case.

The question of materiality of the

3/ 35 U.S.C. Par. 135(b) reads:

> A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

omitted limitations is one of fact, which raises the threshold issue: Which party bears the burden of proof? In effect , a motion to dissolve is an attack on the decision to declare an interference which has been made by the agency and the movant is the proponent of a contrary proposition.

In such circumstances we believe the rule must be that the movant who seeks to dissolve an interference must bear the burden of persuasion to show that the omitted limitation is material. Accord, Aelony v. Arni, 547 F.2d at 571, 192 USPQ at 490. The board thus, correctly, placed the burden on Case and then found that he had failed to carry that burden, conclusions with which the district court agreed.

Turning to the limitations which Case asserts are material aspects of his invention, primarily Case argues that certain weight limitations could not be omitted from the interference counts. However, the court

adopted the board's view that the weights were not material because the ranges of the proportions of components in Case's patent claims were broad and were not pentinent to patentability as shown by the prosecution history. Dr. Case asserts that the holding cannot stand because he always considered the limitations to be "a necessary and integral aspect of his invention." A merely conclusory statement does not lead us to a firm and thorough conviction that a mistake has been made with respect to the immateriality of the weight limitations. The citation to Brailsford v. Lavet, 318 F.2d 942, 946, 138 USPQ 28, 32 (CCPA 1963), where omitted limitations were held to be material, avails nothing to Case. Precedent cannot establish facts.

The second basis asserted for materiality of the limitations is that the "Omission of weight limitations leads to a different invention being claimed (namely,

no invention whatever)." As previously indicated, the counts are not claims to an invention, but in any event, Dr. Case has not put forth evidence which supports his assertion.

No interference in fact means that there is no interferening subject matter, that Case's patent is no impediment to granting CPC the claims of its application. It was Case's burden to prove that CPC claims a different invention from his own. Case cannot carry that burden with argument that the counts are unpatentable.

With respect to other limitations, we need only comment on Dr. Case's assertion that a limitation of 1% water is material to the invention. The patent claims contain no limitation on the percentage of water or, indeed, even a mention of water. Dr. Case would have us incorporate a 1% limitation by referenct to his specification. CPC argues that no 1% limitation can be found

therein. The issue, however, is materiality and we are unpersuaded that a limitation, if critical, would not be found in the claim. On this point, McCabe v. Cramblet, 65 F.2d 459, 18 USPQ 71 (CCPA 1933), is instructive:

> Appellant insists that such limitation should be read into the claims, and that when so read, the counts here involved do not call for the same invention as that embraced in the claims of appellant's patent. However, as said by the Supreme Court in the case of McCarty v. Lehigh Valley Railroad Company, 160 U.S. 110, "* * * we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement." If appellant's disclosure in his patent with respect to the two terminals being in relatively close proximity to each other be of patentable significance, that element should have been expressed in the claims of his patent if he desired to receive protection therefor. Appellant having elected to claim the invention broadly with respect to the positioning of the terminals at the points of entering the tube, is not in a position to insist that limitations be read into his claims for the purpose of avoiding the issue of priority. Deibel v. Heise and Schmacher, 18 C.C.P.A. (Patents) 907, 46 F.2d 570.

Thus, we find no error in the court's

refusal to find the omitted limitations to be material or in its refusal to hold that there was no interference in fact.

IV

Apart from the propriety of the interference counts, Dr. Case raises a number of arguments that need no more than summary treatment.

We agree with the district court that CPC's cancellation of the narrow claims copied from Dr. Case's patent and substitution of claims of broader scope creates no estoppel against CPC's being in the interference on the basis of the broad counts. CPC did not "give up" broad claims to avoid prior art and later seek to assert that narrow claims are the equivalent thereof, which is the usual estoppel situation. He claimed narrowly then more broadly. In an event, Dr. Case is again confusing "claims" and "counts." CPC never claimed and gave up the "counts" and will not obtain the phantom

counts as claims in a patent.

We also affirm the district court's rejection of Dr. Case's contention that CPC's application does not satisfy the requirements of 35 U.S.C. Par. 112, first paragraph.[4/] While CPC did not state a specific amount of propylene oxide, the molar substitution (M.S.) specified in Example 6 was adequate for this purpose according to the board and the expert testimony of CPC's witness, Dr. Parmeter. Similarly, the record establishes that one of ordinary skill would have known to stir and vent the mixture. Contrary to appellant's argument, 35 U.S.C. Par. 112 does not require a specific teaching of that which is already known to one of ordinary skill, nor did the district court reach its

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4/ 35 U.S.C. Par. 112 reads, in pertinent part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise,

conclusions by engaging merely in speculation on these matters.

V

Case further cited Par. 112 as requiring that CPC must have support for the limitations of Case's patent claims. This would be correct only if CPC's application now contained claims copied from the Case patent. Section 112 is, as has been indicated, directed to what a party claims. Section 112 imposes no additional requirement in an interference that a party must support what his adversary claims but he does not.

As part of his argument under Par. 112, appellant asserts that CPC's "claim 61" does not support the corresponding count. However, neither claim 61 nor CPC's

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4/ Cont'd

and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same,. . .

disclosure must support the phantom count. Squires v. Corbett, 560 F.2d 424, 433, 194 USPQ 513, 519 (CCPA 1977). In any event, Case's argument on this point returns to the proposition that the limitations of his claim are material and must be supported by CPC's application, a position we reject. Similarly, Case's argument that Molotsky's parent application has an inadequate disclosure is rejected. Again, limitations assertedly unsupported are not in CPC's claims.

VI

Dr. Case argues that the board erred in holding for CPC because CPC offered no testimony in the interference. Appellant cites Aelony v. Arni, supra, for the restrictive proposition that, for evidence to be considered by the board, it must be in the form of testimony, In Dr. Case's view, since CPC presented no testimony to

the board,5/ CPC forfeited any chance to prevail. This argument is wholly fallacious. An interference may be decided simply on the basis of the PTO files of the involved cases. Aelony holds no more than that, if additional evicence is present, it must be introduced into the record in accordance with the procedural rules of the board.

Secondly, Dr. Case would have us rule out acceptance by the district court of Dr. Parmerter's testimony which was not presented to the board in view of authority holding that "a deliberate, intentional or willful withholding or suppression of pertinent and available evidence from the Patent Office . . . justifies exclusion of such evidence in a (35 U.S.C.) Par. 146 proceeding." Kirschke v. Lamar, 426 F.2d 870, 874, 165 USPQ 679, 683 (8th cir. 1970).

5/ It must be noted that Dr. Case presented none either.

The provision of 35 U.S.C. Par. 146 which provides for review of the Board of Interferences by civil action in a district court explicitly states that the administrative record may be admitted "without prejudice to the right of the parties to take further testimony." We are aware that this provision has received varying interpretations in the circuits.[6/] In our view, since an action under 35 U.S.C. Par. 146 has the hybrid nature of an appeal and a trial de novo, the statute authorizes the district court to accept all proffered testimony on issues raised by the parties during the proceedings below or by the board's decision. Whether under some circumstances a district court may properly restrict the admission of testimony on an issue raised before the board is not before us. The

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6/ See T.J. MacPeak, "Appeal from Decision of the Board," Interference Practice, pp 8-9 to 8-14 (1982) for a review of the case law.

court here accepted the testimony and we find no error in its doing so.

Other arguments, principally of factual matters, have been adequately dealt with in the decisions below and it would serve no purpose to deal with them in detail here. Accordingly, we will simply state that appellant's arguments of other errors are rejected.

VII

Appellant sought to amend his complaint to bring a suit against the Commissioner of Patents and Trademarks pursuant to 28 U.S.C. Par. 1346(b), which permits certain tort claims against the Government. The alleged basis for the claim is that the Commissioner erred in instituting the interference which resulted in an award of priority to CPC. We affirm the holding below that 28 U.S.C. Par. 1346(b) does not waive governmental immunity from suit with respect to the acts of the Commissioner of Patents and Trademarks

complained of by appellant and that the Government was properly not forced to become a party to the action.

VIII

In sum, since the Case patent and the CPC application contain interfering subject matter, an interference proceeding was appropriate. Second, the counts of the interference were not shown to be improperly drawn. Third, CPC was entitled to an award of priority on the basis of its earlier filed application. Lastly, the Commissioner of Patents and Trademarks was properly dismissed as a co-defendant.

In view of the foregiong, the judgement of the district court is affirmed. The parties shall bear their own costs.

AFFIRMED

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

LESLIE C. CASE, Appellant, v. CPC INTERNATIONAL, INC., and COMMISSIONER OF PATENTS AND TRADEMARKS, Appellees.	)	No. 83-964

ORDER

A suggestion for rehearing in banc having been filed in this case,

UPON CONSIDERATION THEREOF, it is Ordered by the court that the suggestion for rehearing in banc be, and the same is hereby, Declined.

FOR THE COURT

George E. Hutchinson,
Clerk

March 27, 1984
Date

cc: Leslie C. Case
Keith V. Rockey

AMENDMENTS TO THE CONSTITUTION

ARTICLE V

No person shall be held to answer for a capital or other i famous crime unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the militia, when in actual service, in time of war or public danger; nor shall any person be subject for the same offense to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use without just compensation.

35 UNITED STATES CODE (PATENTS)

35 USC 135 INTERFERENCES

(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

35 USC 146 CIVIL ACTION IN CASE OF INTERFERENCE

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The

Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

PATENT AND TRADEMARK OFFICE RULES

RULE 204(a) (37 CFR 1.204(a))

The fact that one of the parties has already obtained a patent will not prevent an interference. Although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who, in the interference, proves himself to be the prior inventor.

RULE 205 (37 CFR 1.205)

(a) Before an interference will be declared with a patent, the applicant must present in his application, copies of all of the claims of the patent which also define his invention and such claims must be patentable in the application. However, an interference may be declared after copying the claims excluding an immaterial limitation or variation if such immaterial limitation or variation is not clearly supported in the application or if the applicant otherwise makes a satisfactory showing in justification thereof.
(b) Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure, unless the claim is copied in response to a suggestion by the Office. The examiner will call to the Commissioner's attention any instance of the filing of an application or the presentation of an amendment copying or substantially copying claims from a patent without calling attention to that fact and identifying the patent.

RULE 206 (37 CFR 1.206)

(a) Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion the applicant cannot make the other claims and state further that the interference will be promptly declared. The applicant may proceed under Rule 231 if he desires to further contest his right to make the claims not included in the declaration of the interference.
(b) Where the examiner is of the opinion that none of the claims can be made, he shall reject the copied claims stating in his action why the applicant cannot make the claims and set a time limit, not less than 30 days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit shall be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed will, in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

RULE 341(g) (37 CFR 1.341(g))

FORMER EXAMINERS. No person who has served in the examining corps of the Patent and Trademark Office will be registered after termination of his services, nor, if registered before such service, be reinstated, unless he undertakes: (1) Not to prosecute or aid in any manner in the prosecution of any application pending in any examining group during his period of service therein; and (2) not to prepare or prosecute nor to assist in any manner in the preparation or prosecution of any application of another filed within 2 years after the date he left such group, and assigned to such group, without the specific authorization of the Commissioner.

28 UNITED STATES CODE

28 USC 1346 (TORT CLAIMS)

(b) Subject to the provisions of chapter 171 of this title, the district courts, together with the United States District Court for the District of the Canal Zone and the District Court of the Virgin Islands, shall have exclusive jurisdiction of civil actions on claims against the United States, for money damages, accruing on and after January 1, 1945, for injury or loss of property, or personal injury or death caused by the negligent or wrongful act or omission of any employee of the Government while acting within the scope of his office or employment, under circumstances where the United States, if a private person, would be liable to the claimant in accordance with the law of the place where the act or omission occurred.

MOTION FILED

JUL 19 1984

83-2084

IN THE SUPREME COURT OF THE
UNITED STATES OF AMERICA
OCTOBER TERM, 1983

LESLIE C. CASE,
Petitioner,

vs.

CPC INTERNATIONAL, INC. and

COMMISSIONER OF PATENTS AND TRADEMARKS
Respondents,

IN SUPPORT OF
PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF OF WENDELL S. MILLER AMICUS CURIAE, PRO SE.

WENDELL S. MILLER, Patent agent
as Amicus Pro Se

July 18, 1984 (Reformated)

BEST AVAILABLE COPY

MOTION

Amicus Curiae, Wendell S. Miller, moves for leave to file a brief om behalf of the jurisdictional statement of Petitioner Leslie C. Case for a Writ of Certiorari to the Court of Appeals for the Federal Circuit. The offered brief accompanies this motion.

Amicus was very recently informed of this present posture of his case by Dr. Case in order that such a brief as this might be submitted were that desired.(consent obtained)

Amicus has contacted counsel for Respondent, CPC, International, Inc. by phone and has been informed that duty to his client dictates that he cannot approve a request to submit this brief.(consent not obtained)

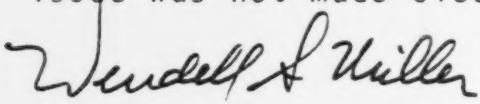
Amicus is acting solely on his own behalf and has no personal or professional connection with Petitioner Case or Respondent, CPC International or its counsel. He is, however, a Registered Patent Agent, #20,358 and, in practice before the Office of Respondent,(consent not obtained)

Commissioner of Patents and Trademarks, has a vital and continuing interest in the correct statement of the patent law. Amicus has been involved with patent interferences and their sequels since 1967 and has a comprehension of the nuances of interference law and practice.

In the instant case, there is an important principle of the law related to interferences which has been misstated and misapplied by the court, no doubt in response to the form of advocacy which Dr. Case's brief displays. The Petitioner, acting pro se, has appreciated that there is a fundamental error in the successive decisions in this matter by Examiner, Board and Courts. From the reported decisions, it appears that he has adequately stated the essential facts and, perhaps indistinctly, pointed to the law. However, he has allowed the main point to become obscured by a welter of extraneous issues.

The public will be bound through stare decisis by the law stated below. In fairness

to its right to a correct statement, Amicus requests that his brief be considered lest the public be permitted to suffer because this action was so prosecuted that the important issue was not made clear to the court.



Wendell S. Miller

83-2084

IN THE SUPREME COURT OF THE
UNITED STATES OF AMERICA
OCTOBER TERM, 1983

LESLIE C. CASE,
Petitioner,

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CPC INTERNATIONAL, INC. and

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IN SUPPORT OF
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UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

BRIEF OF WENDELL S. MILLER AMICUS CURIAE, PRO SE.

WENDELL S. MILLER, Patent agent
as Amicus Pro Se

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CITATIONS

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The decision of the Court of Appeals for the Federal Circuit (CAFC) in this case contains the statement:

> No purpose would be served in determining patentability of the count itself over prior art, particularily a phantom count, which by definition neither party asserts as a claim.
> 730 F2d 745, 749; 221 USPQ 196,199

This statement is erroneous in failing to appreciate the significance of the count being patentable over prior art. If uncorrected, it will unnecessarily destabilize an important area of patent practice already mired in a welter of confusing precepts. It results in a wrong decision in this case. An illustrative example below will show the nature of the problem.

A patent interference is a proceeding before the Board of Patent Interferences (BPO) of the Patent and Trademark Office (PTO) to determine which of two or more inventors is entitled to be considered amongst them as the first inventor de jure.

It is not to determine other aspects of patentability of any invention to anyone except as such may be necessary to accomplish this specific object. The CAFC has focused on the first half of the preceeding sentence and ignored the emphasised second half. The aspects of patentability which must be so considered are termed "ancillary to priority". A slavish attention to specific catagories of aspects which have been so dubbed, without application of the above emphasised criterion, leads to much wasteful strife and injustice.

PHANTOM COUNT PRACTICE

In "Phantom Count' practice, here involved, the issue is expressed as a count in which various limitations appearing in the claims of each of the parties are omitted. Such count is thus broader than any claim which can be made by any of the parties and indeed is unpatentable to each of them as none presumably has disclosed

an invention of such broad scope—had one, the count need not be a phantom.

However, as specifically stated at §1101.02 II(b) of the PTO Manual of Patent Examining Procedure: "Further, such a 'phantom' count must be patentable over the prior art." An example, closely analogous to that of this case, shows why this must be so.

Assume that there is as prior art a product, "rubber vulcanized with 5 to 10 units of sulfur, suitable for tire tread." Assume also that party A invents a product, "rubber vulcanized with 40 to 50 units of sulfur, suitable for bowling balls; and that then party B invents and patents a product, "rubber vulcanized with 1 to 2 units of sulfur, suitable for surgeons gloves." Each of these inventions may be separately patentable at least in its own range of limitation.

Let the party A, after seeing B's

claim published, copy that claim and through persuasive advocacy procure the Primary Examiner to declare an interference with B. The count would need be a "phantom" calling for "rubber vulcanized with 1 to 50 parts sulfur", so that it cover both A and B.

Under these assumptions and the law as stated now by the CAFC, A would be ruled the "prior inventor" of the count between A and B, and B would be divested of his proper patent right. A could not receive a patent on B's invention; he neither invented nor disclosed it. However, A would have achieved freedom to practice B's invention without paying royalty.

The reason for such an anomaly is that this phantom count is not patentable over the prior art. There is thus a crucial purpose to "be served in determining patentability of the count over prior art".

Specifically, the statutory authorization, 35 USC 135, to the extent it

speaks, contemplates an interference where the inventions claimed are the "same or substantially the same subject matter". Rule, 37 CFR §1.205(a), effects this by permitting as counts "claims excluding an immaterial limitation or variation".

To have an interference declared, each party's respective claims must first be found patentable in their respective applications or patents except for the mutual issue of priority. If a count is synthesized from these patentable claims by suppression of some limitation, and such new count is then not patentable over the prior art, the suppressed limitation could not have been "immaterial". This conclusion applies to any count with suppressed limitations, not just to "phantoms."

In the present case, the District Court correctly stated the law as far as it went, but did not reach the crucial factual allegation of invalidity of the count over

the prior art. The CAFC on the other hand, preceived that factual allegation but then by misstating the law, denied its own jurisdiction and that of the District Court and the BPI to address the issue.

Under this ruling, the determination of the materiality of the deleted limitation is left to the Primary Examiner alone. That occurs ex parte with the claim copier, the party in A's position in the example above. If B is a patentee, A will have had access to B's entire patent file including any of his priority date assertions in 37 CFR §1.131 affidavits. A further will have had the opportunity for ex parte interviews with the examiner to argue his views and present evidence. B, however, never has a right to present "affidavits, declarations or evidence outside of official records and printed publications". 37 CFR §1.231(a)(1). He has no right to an oral hearing corresponding to A's interview, and there is review by no

other officer, board or court. This dissymetry or right is a far cry from fairness or any concept of due process, especially when it is the patentee with a vested right that is the one deprived. This is not an abstract possibility. It is exemplified in the present case.

JURISDICTION

The CAFC further elliptically cites the remarks of Chief Judge Markey, concurring, in Tofe v. Winchell 645 F2d at 64, 209 USPQ at 385, listing issues that have been held to be ancillary to priority. That citation states farther on:

> Whether an application is defective is critical, not just ancillary, to the right to a patent. It may also be viewed as involved in the requirement that there be at least two applications (or an application and a patent) available for interference, that is as going to the jurisdiction of the board. Thus defects in the application relate to or are "ancillary" to, the question of who was the first to make the invention.
>
> The defects refered to are not

invalidity over prior art and the like. an application may be unpatentable for such a reason without being defective. "Defects" rather are such matters as abandonment of invention by virtue of 35 USC §185, fraud in prosecution, failure to make the oath or to pay the fees or to include an essential part of the specification or claims.

There may be some reason to determine priority between parties when there is an early, provable actual reduction to practice, though it is doubtful interference is the proper way when neither party can be eligible to obtain a patent. However, in a case such as this where the "date of invention" is determined by the date of filing of a complete application (constructive reduction to practice) the threshold question is clearly patentability of the count in the sense of completeness and propriety of prosecution of the affected applications.

A definitive statement of this principle is sorely needed to cut through the present fog of decisions.

In an earlier motion to this Court, Case v. Commissioner of the Patent and Trademark Office, Motion for Leave to File Petition for Writ of Mandamus, 75-1566, the present petitioner sought a writ of mandamus to compel the Commissioner of the PTO to inquire into asserted aspects of fraud in his Office as related to the prosecution of his opponents application. In the Opposition to his request filed on behalf of the PTO, the government denied that the Commissioner had any mandatory duty to inquire into fraud alledged to be being practiced at his Office. (antepenultimate par.)

The patent community shook its head cynically at such an allegation which denies a basic duty of any department head and goes squarely against the dictum of this Court in

McCormick Harvesting Mach. Co. v. Aultman

> Had the original patent been procured by fraud or deception, it would have been the duty of the Commissioner of Patents to have had the matter referred to the Attorney General with a recommendation that a suit be instituted to cancel the patent.
> 169 US 606, 18 SCt 443, 42 LEd 875

The Commissioner's denial of such a duty shows the extreme need for a clear instruction to the PTO to take action on fraud as the "threshold" question in any of its deliberations wherein it is properly raised. It is better to scotch fraud at its first appearance before other proceedings are wastfully conducted than to allow it to do its damage to the rights of others and to the confidence of the public in the patent system.

Wendell S. Miller

mandamus to compel the Commissioner to grant petitioner's motion to take interrogatories and to take notice of the alleged discrepancies. The district court dismissed the action (Pet. 8). The court of appeals affirmed, on the ground that petitioner's complaint, although framed in terms of mandamus, sought judicial review of an interlocutory decision of the Patent Office (Pet. App.).

2. The court of appeals correctly affirmed the dismissal of this action. Although 35 U.S.C. 146 gives the district courts jurisdiction to review final decisions of the board of patent interferences on questions of priority, it does not authorize review of interlocutory decisions of the board. Cf. *Sanford* v. *Kepner*, 344 U.S. 13; *Phillips Petroleum Company* v. *Brenner*, 383 F.2d 514 (C.A.D.C.). As petitioner concedes (Pet. 11), the interference proceeding at issue has not yet been terminated, and the board has issued no final decision on priority. Accordingly, the district court was without jurisdiction.

In any event, neither the board nor the Commissioner has a mandatory duty to require interrogatories in a patent interference proceeding, or to investigate charges of fraud.[1] Accordingly, mandamus will not lie.

[1] *Precision Instrument Manufacturing Company* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806, upon which petitioner relies, is inapposite, since the Court held there only that the failure of a party to Patent Office proceedings to report to the Office all facts concerning possible fraud underlying the applications at issue barred that party from seeking equitable relief in a subsequent suit for infringement of the patent.

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No. 83-2084

In the Supreme Court of the United States

OCTOBER TERM, 1983

LESLIE C. CASE,

Petitioner,

vs.

CPC INTERNATIONAL INC. and
COMMISSIONER OF PATENTS AND TRADEMARKS,

Respondents.

On Petition for Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENT CPC INTERNATIONAL INC. IN OPPOSITION

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RULE 28.1 STATEMENT

Respondent CPC International Inc. has no parent companies, subsidiaries (apart from wholly-owned subsidiaries) or affiliates.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1983

No. 84-2084

LESLIE C. CASE,

Petitioner,

vs.

CPC INTERNATIONAL INC. and
COMMISSIONER OF PATENTS AND TRADEMARKS,

Respondents.

On Petition for Write of Certiorari to the
United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENT CPC INTERNATIONAL INC. IN OPPOSITION

This petition presents no question warranting this Court's attention.

Petitioner notwithstanding, the Court of Appeals decided this case in accordance with principles of law which (a) have been long settled and (b) are well grounded in the patent law.

This brief for respondent will begin with a counter-statement of the facts, since petitioner has not stated the case either fully or fairly.

COUNTERSTATEMENT OF THE CASE

A. The Parties And The Issues.

This case arises from an interference proceeding decided by the United States Patent and Trademark Office in October of 1976. Petitioner is the inventor and owner of U.S. patent No. 3,510,471, issued on an application filed in the Patent and Trademark Office on March 9, 1967. It discloses and claims a complex chemical composition of a polyether polyol produced from a polysaccharide such as starch.

Respondent CPC International Inc. (hereinafter "CPC") is the owner, by assignment of Dr. Hyman M. Molotsky, of a pending patent application Serial No. 105,684, accorded an effective filing date of January 3, 1967.* Because the CPC application disclosed, in the view of the Patent and Trademark Office, substantially the same composition, the Patent Office instituted pursuant to Title 35, United States Code, §135, an interference proceeding between petitioner's patent and respondent's application to determine who, as between petitioner and Molotsky, was the first inventor.

B. The Case Patent.

Petitioner's patent claims a mixture prepared by reacting (a) a polyalcohol such as glycerin and (b) a polysaccharide such as starch with a compound known as an

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* The CPC application was, in fact, filed on January 11, 1971. Since it included the same subject matter as had been disclosed in application Serial No. 606,596, which had been filed in January of 1967, the later application, called a continuation-in-part, was given the effective filing date of the first application under Title 35, United States Code, §120.

alkylene oxide. That reaction is referred to by chemists as an oxyalkylation reaction and produces an oxyalkylated alcohol in admixture with an oxyalkylated polysaccharide.

Petitioner's claim 1 describes a class of polyalcohols used in carrying out that oxyalkylation reaction. He defines them as aliphatic alcohols containing 3-9 carbon atoms and a minimum of 3 alcohol or hydroxy groups. Glycerin is the simplest alcohol of that group.

Similarly, the polysaccharides used by petitioner are described as containing at least 3 saccharide units per molecule. Starch, of course, meets that definition, containing several hundred such units.

Petitioner's patent says that the number of alkylene oxide groups reacted with each of the polysaccharide and the polyalcohol ranges from about 1.0 to about 3.0 on the average. The proportions between the polysaccharide and the polyalcohol are such that the oxyalkylated polyalcohol makes up 10-95% by weight of the mixture while the oxyalkylated polysaccharide represents the remainder, 90-5% of the composition.

C. The First Molotsky Application.

Respondent's first application, Serial No. 606,596, was filed on January 3, 1967 in the name of Hyman M. Molotsky as the inventor. In essence, it describes oxyalkylated starches prepared by reaction of an alkylene oxide with starch in the presence of a solvent.

The '596 application, like petitioner's patent, teaches the proportion of alkylene oxide used, calling for a "molar substitution" ranging from about 3.5 to about 50. That

range corresponds to a number of alkylene oxide units reacted with the starch within the range of about 1.1 to about 17 — thus overlapping petitioner's claimed range of about 1.0 to 3.0.

Respondent's '596 application teaches that starch can be reacted with the alkylene oxide in the presence of a reactive solvent like glycerin. Example 6 of the application is a specific embodiment describing a polyether polyol prepared by reaction of starch and glycerin with propylene oxide.

As the Patent Office and the courts below concluded, Example 6 falls squarely within the claims of petitioner's patent.

D. Molotsky's C-I-P Application.

Respondent, in January of 1971, refiled the '596 application as a continuation-in-part. The latter application was given Serial No. 105,684 with a filing date of January 11, 1971.

The '684 application contained all of the same disclosure as the original application — including Example 6 — as well as newly-added disclosure.

E. The Declaration Of The Interference.

Because petitioner's complaint stems from the procedures followed by the Patent Office in instituting an interference proceeding, we shall, with due regard for brevity, briefly describe that procedure.

Under Patent Office rules regarding interference procedure, an applicant, to provoke an interference with a patent, must submit claims in his application which are

"copied or substantially copied" from the patent (37 CFR §1.205(b)). Because respondent did not define its invention in the same words as did petitioner, respondent could not support petitioner's patent claims verbatim, and notably the definition of the alcohol as containing 3-9 carbon atoms and at least 3 hydroxy groups. However, respondent did disclose several alcohols which met petitioner's definition, and hence could nonetheless present a claim defining the same invention, albeit in different terms.

The Patent Office therefore suggested that respondent present claims in its application which defined the same invention as called for by petitioner's patent, but using language which respondent's application could support. Respondent did just that, presenting claims which embrace a polyether polyol prepared by reaction of starch and glycerin with an alkylene oxide.

The Patent Office thus instituted an interference between the Molotsky application and petitioner's patent. Since the "count" of the interference — a claim which defines the interfering subject matter — must embrace both the application claim and the patent claim, the Patent Office formulated, as count 1, a count just like petitioner's claim 1, except that it did not include the proportions of the oxyalkylated polyalcohol and the oxyalkylated polysaccharide. The Patent Office examiner ruled that those proportions amounted to "an immaterial limitation" in Petitioner's claims within the meaning of 37 CFR §1.205(a).

The Examiner's holding was affirmed by the Board of Patent Interferences. The Board awarded priority of the counts to respondent, relying on petitioner's never having

attempted to prove any date of invention prior to his filing date. The Board thus concluded that because respondent's application had an earlier filing date evidencing constructive reduction to practice of the subject matter disclosed in that application, respondent was entitled to prevail.*

The Board of Patent Interferences specifically rejected the points which petitioner asserts here. Thus:

(1) The Board dismissed petitioner's contention that his patent claim defined different inventions because the latter did not include the proportions of oxyalkylated polyalcohol and oxyalkylated polysaccharide. Recognizing that, notwithstanding the difference in wording, the invention claimed by petitioner was the same as that disclosed by respondent, the Board noted (A 10):

> "It is thus apparent that both Case and Molotsky disclose carrying out the same reaction so that both necessarily obtain the same product."

(2) The Board rejected petitioner's argument that the counts were improperly constituted in failing to recite the proportions of the two components, noting that petitioner had failed to carry his burden of proving that proportions outside the patent claims but within the counts represented a patentably different invention.

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* It is settled law that the filing of a patent application is constructive reduction to practice of the subject matter disclosed in it. A party seeking to prove an earlier date for that subject matter must show, by competent evidence, that he in fact made the invention on a date earlier than his filing date. See, for example, *Beeber* v. *Krogh,* 403 F.2d 743, 745 (CCPA, 1968).

F. The Decision Of The District Court.

The District Court, after a full trial on the merits, dismissed petitioner's complaint, finding that respondent was entitled to prevail as a matter of law. The District Court, like the Patent Office before it, resolved the matter on the basis that petitioner, establishing no date of invention prior to his March 1967 filing date, had failed to antedate respondent's filing date of January 1967.

The District Court rejected as legally unfounded petitioner's argument that respondent had to copy petitioner's patent claim verbatim. Relying on the decision of the Court of Customs and Patent Appeals in *Squires* v. *Corbett,* 560 F.2d 424 (CCPA, 1977), the District Court held that respondent need only present claims directed to the same invention as petitioner's patent claims.

While noting that petitioner argued that his patent claims were directed to a different invention, the District Court dismissed that argument, observing that petitioner had failed to carry his burden of proof on that issue. In that regard, the District Court relied on the expert testimony of Dr. Stanley M. Parmerter. The District Court, noting that Parmerter's testimony was in conflict with that advanced by petitioner himself, adjudged Parmerter to be worthy of belief, and rejected petitioner's testimony as incredible.*

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* The District Court was so persuaded by Parmerter's testimony that it adopted Parmerter's testimony "as part of my findings" (A 40).

G. The Decision Of The Court Of Appeals.

The Court of Appeals, relying on long-standing precedent of its predecessor Court of Customs and Patent Appeals, affirmed the judgment of the District Court.

Respecting petitioner's contention that his invention was somehow different from that disclosed in respondent's application because the count did not include the proportions of components, the Court held that petitioner had simply failed to carry his burden of persuasion that somehow those omitted limitations were material. It rejected outright petitioner's contention, reiterated in his Petition, that an interference can be declared only if an applicant copies patent claims verbatim.

Argument

The facts themselves make a compelling showing that there is involved here no matter warranting this Court's attention. Indeed, this case was a routine patent interference in which petitioner, as junior party, failed to establish that he had made his invention before respondent did. Petitioner's loss in the courts below was, in reality, occasioned by a failure of proof, rather than any defect in the procedures followed, as will now be shown.

I. The Statute Not Only Authorizes But Compels The Patent Office To Follow The Procedures Criticized In This Case.

The starting point for an analysis of the procedures followed by the Patent Office in this case is Title 35, United States Code, §135, providing that whenever a patent application "in the opinion of the Commissioner, would interfere with any pending application, or any unexpired patent", the Commissioner shall give notice and determine, through the Board of Patent Interferences, the question of priority of invention.

The statute addresses explicitly the very point which petitioner here raises as violative of the law, namely that §135(b) calls for an interference when an application claim is "the same as, or for the same or substantially the same subject matter as" a patent claim. In other words, the statute says that an interference shall be declared when the claims are for the same invention *or substantially the same* invention.

That same policy is carried through in the rules promulgated by the Commissioner of Patents, and notably 37

CFR §1.205 which petitioner attacks here. §1.205 provides that a claim should be "copied or substantially copied" from a patent. That sets at naught any requirement imagined by Petitioner that an application copying a patent claim must copy that claim verbatim.

All else aside, this Court has long since recognized that a numerical range in a patent claim normally does not set it apart as a separate invention. A numerical limitation must correspond to a newly-discovered physical phenomenon before it can set that claim apart from the prior art. *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U.S. 320, 329 (1945) That is yet a further reason why the omitted proportions, which Petitioner relies on so heavily, cannot distinguish his invention from that of Respondent.

In sum, there is just no substance to Petitioner's argument that there was a failure to "declare and conduct the interference in accordance with the rules" (Petition, p. 21).*

II. The Other Arguments Advanced By Petitioner Are Equally Groundless.

Petitioner's other ground for seeking review in this Court is that the practices followed in the Patent Office and the courts below are gravely injurious to the public.

That, as an argument, just will not wash. Rather than being injurious to the public, the procedures followed here prevent the public from being subjected to two patents on

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* Having shown that the Patent Office and the courts below did properly resolve the question of priority, the other points raised by Petitioner are moot.

inventions which are the same, though expressed in somewhat different claim language. Indeed, had the Patent Office and the courts below viewed this case in any other way, as Petitioner urges, there would be two patents on the books, owned by separate parties and each covering a polyether polyol prepared by reaction of starch, glycerin and an alkylene oxide.

Conclusion

The petition here is utterly lacking in merit, and should be denied.

Respectfully submitted,

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